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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,708	12/16/2003	Masahiro Naiki	740709-514	3453
22204	7590	08/27/2007	EXAMINER	
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			MOORE, MARGARET G	
			ART UNIT	PAPER NUMBER
			1712	
			MAIL DATE	DELIVERY MODE
			08/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/735,708

**Applicant(s)**

NAIKI ET AL.

**Examiner**

Margaret G. Moore

**Art Unit**

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 to 18 is/are pending in the application.
- 4a) Of the above claim(s) 1 to 7, 14 to 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8 to 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

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1. Applicant's election without traverse of Group I in the reply filed on 7/9/07 is acknowledged.

Please note that as a result of this election, the application has been transferred and is currently being examined by Examiner Margaret Moore.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 8 to 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenfeld et al.

Rosenfeld et al. teach adhesive compositions that contain a polyimidesiloxane, an epoxy compound and an isocyanate. Particular attention is drawn to column 1, line 50, to column 4, line 45, which teaches a polyimidesiloxane meeting the required resin of claim 8, as well as claims 9 and 10. The epoxy compound can be present in an amount of 20 to 100 phr and the isocyanate can be present in an amount of 10 to 20 phr. See columns 7 and 8.

This reference does not specifically teach an epoxy compound having the epoxy equivalent weight present in the amount as claimed, but one having ordinary skill in the art would have found such an amount and type of epoxy to have been obvious. For instance, note the top of column 10 which teaches an epoxy having an equivalent weight of 875. Again note column 7, line 32, which teaches that the epoxy can be present in an amount of 20 phr (based on polyimide). It would have been within routine experimentation of the teachings of Rosenfeld et al. for one having ordinary skill in the art to include 20 phr of the epoxy having an equivalent weight of 875 in the composition thereof. Note for instance that Example 2 contains 25 phr of this resin. The skilled artisan would have found the use of 20 phr rather than 25 to have been obvious since 20 is a

specifically disclosed lower limit for the amount of epoxy in this composition. In this manner the instant claims would have been obvious.

For claim 12, see column 7, lines 45 to 55. For claim 13, see column 9, lines 43 to 45.

For claim 11, this reference does not specifically teach the addition of a curing catalyst but the skilled artisan would have found the addition of a catalyst to the composition of Rosenfeld et al. obvious, in an effort to improve cure rate. It is quite well known in the art to add catalysts in an effort to improve and/or optimize cure rate.

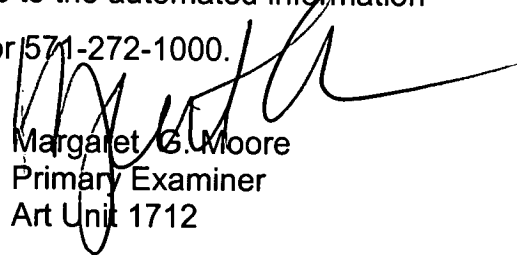
4. Ishikawa et al. is cited as being of general interest. This reference teaches a polyimidesiloxane and a isocyanate, the latter being used as an improvement over epoxy resins. Naiki et al. has a common inventor with the instant application. This reference does not qualify as prior art due to its later filing date. Also no double patenting rejection applies since the claims therein are drawn to a patentably distinct product.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Margaret G. Moore  
Primary Examiner  
Art Unit 1712

mgm  
8/23/07